

Appl. No. 10/701,039
Atty. Docket No. 5922R2CCC
Amdt. dated November 9, 2005
Reply to Office Action of August 10, 2005
Customer No. 27752

REMARKS

Claims 1-19 remain pending in this Application and are presented for the Examiner's reconsideration in light of the following comments. The Examiner has objected to Applicants' Specification for not providing basis in the Specification for the subject matter of Claims 1 and 20. Claim 1 has been amended to remove the objectionable phrase and claim 20 has been cancelled.

Rejection Under 35 U.S.C. §112

Claims 1-20 have been rejected under 35 U.S.C. §112, ¶1, as based on a disclosure which is not enabling. The Office Action provides that elements deemed by the Office to be essential to the practice of the invention are not included in the claim(s) is (*sic*) not enabled by the disclosure. In the alternative, the Office Action provides that the claims are too broad since the claims purport to cover any combination which imparts the desired characteristics, and that undue experimentation would be required to determine what would and would not infringe. Applicants respectfully traverse this rejection.

First, there is no recognized "essential elements test" for patentability. See *Amgen Inc. v. Hoechst Marion Roussel, Inc.* 314 F.3d 1313, 1333, Fed. Cir. (2003). Applicants submit that the written description provides sufficient enablement for the invention as claimed. The written description provides disclosure as to the making and use of material having the particular claimed limitations.

As to the breadth of the claims, Applicants submit that the claims relate to an article of manufacture having particular limitations. The Office Action does not specify any particular limitation as not being adequately enabled but rather provides that the claims appear to read upon materials that could not possibly be used to form the contemplated genus or subgenus of articles and that undue experimentation would be necessary to determine what would and would not infringe. Applicants respectfully submit that in the case of materials that could not possibly be used to form the contemplated genus it is instead obvious that such materials – as provided in their description – do not infringe since they cannot possibly form the claimed material.

If, as the Office Action provides, the scope of the claims is overly broad, then the Office must specify which limitation of the claims is not enabled. A sheet material

Appl. No. 10/701,039
Atty. Docket No. 5922R2CCC
Amdt. dated November 9, 2005
Reply to Office Action of August 10, 2005
Customer No. 27752

satisfying each of the claimed limitations would infringe regardless of the composition of said sheet. Unless the Office can provide a prior art reference that defines the limits of the compositions from which such a sheet has heretofore been made, Applicants submit that any such sheet is within the scope of the claims as set forth.

The Examiner has rejected Applicants' Claims 1-20 under 35 U.S.C. §112, ¶2 for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. Applicants respectfully traverse this rejection. The Examiner relies for this contention upon *Ex parte Slob*, (PO BdApp) 157 USPQ 172. In the reference, the Examiner provided a listing of materials which satisfied a physical property limitation regarding the liquefaction temperature of the material and the other claimed limitations but which would be unsuitable for the claimed use. Applicants submit that unlike the cited case, the Examiner has not provided a listing of materials which would satisfy all other claimed limitations yet somehow fall outside the scope of the claims. Applicants' claims do not revolve around a physical property of a material but rather around a combination of limitations of an article. Applicants respectfully request that this rejection be reconsidered and withdrawn.

Additionally, Applicants have amended Claim 1 to clarify that the limitation "protrusions comprising from about 30% to about 70% of said first active side" relates to a percentage of the area of the sheet material as provided at page 27, lines 33-35.

Rejection Under 35 U.S.C. §101

Claim 20 has been rejected under 35 U.S.C. §101 because the claimed invention lacks patentable utility. Claim 20 has been cancelled.

Double Patenting

The Examiner has rejected Claims 1, 2, 4, 6, 7, 13, 16 and 17 for obviousness-type double patenting over:

Claims 1, 2, 5, 7, 8, 14, 16, 17, 19, and 24 of U.S. Patent No. 6,194,062;

Claims 1, 2, 4, 7, 8, and 9 of U.S. Patent No. 6,818,292;

Claims 9, 10, 14, 15, 18, 41, 50, 52, 55, 58, 66, 95, 97, 98, 100, 101, 105, 106, and 108 of co-pending Patent Application No. 09/715,586;

Claims 3, 4, 10, 12-14, 17, 38-41, 47, 49-51, 53, 54, 86-89, 97-99, and 102 co-pending

Appl. No. 10/701,039
Atty. Docket No. 5922R2CCC
Amdt. dated November 9, 2005
Reply to Office Action of August 10, 2005
Customer No. 27752

Patent Application No. 09/716,740; and
Claims 1, 7, 10, and 16 of co-pending Patent Application No. 10/003,900.

Pursuant to M.P.E.P. §1490, Applicants will submit an appropriate Terminal Disclaimer compliant with 35 U.S.C. §253 and 37 C.F.R. §3.73 at such a time as allowable subject matter has been identified which remains subject to a double patenting rejection.

Rejections Under 35 U.S.C. §102/§103

Claims 1, 2, 4-9, and 11-17 have been rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a), as obvious over Wilbur, U.S. Patent No. 2,338,749. Applicants respectfully traverse this rejection. The cited reference provides no teaching or suggestion relating to the proportion of the adhesive portion of the sheet that should be present in the form of protrusions. Since the reference provides no teaching regarding a range of protrusion amount or any indication that such a feature is of any significance, the reference cannot be found to have taught or suggested that a sheet having protrusions in the range of 30% to 70% of the sheet area as provided by the rejection. Applicants submit that this rejection should be reconsidered and withdrawn.

Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Wilbur (U.S. Patent No. 2,338,749), in view of Reed, et al. (U.S. Patent No. 4,054,697). As provided, the Wilbur reference fails to anticipate or render obvious the invention as set forth in the claims as amended. The addition of the Reed reference fails to cure the deficiencies of the Wilbur reference as to Claim 1 and as Claim 3 depends from Claim 1 this rejection should be reconsidered and withdrawn.

Claim 10 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Wilbur (U.S. Patent No. 2,338,749), in view of the admitted prior art. As provided, the Wilbur reference fails to anticipate or render obvious the invention as set forth in the claims as amended. The addition of the admitted art reference fails to cure the deficiencies of the Wilbur reference as to Claim 1 and as Claim 10 depends from Claim 1 this rejection should be reconsidered and withdrawn.

Claims 18 and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wilbur (U.S. Patent No. 2,338,749), in view of Reed, et al. (U.S. Patent No. 4,054,697), and Kovac (U.S. Patent No. 3,819,467). As provided, the Wilbur reference fails to anticipate or render obvious the invention as set forth in the claims as amended. The addition of the Reed and Kovac

Appl. No. 10/701,039
Atty. Docket No. 5922R2CCC
Amdt. dated November 9, 2005
Reply to Office Action of August 10, 2005
Customer No. 27752

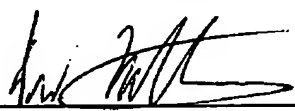
references fail to cure the deficiencies of the Wilbur reference as to Claim 1 and as Claims 18 and 19 depend from Claim 1 this rejection should be reconsidered and withdrawn.

Conclusion

Based on all the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512. If any additional charges are due, the Examiner is authorized to deduct such charges from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,
JOHN WILLIAM TOUSSANT, ET AL.

By 
David K. Mattheis
Attorney for Applicant
Registration No. 48,683
(513) 634-9359

November 9, 2005
Customer No. 27752